



30 SEP 2003

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In re Application of	:	
BOND, Thomas Eugene	:	DECISION ON PETITION
Application No.: 09/720,042	:	UNDER 37 CFR 1.137(b)
PCT No.: PCT/AU99/00486	:	
Int. Filing Date: 17 June 1999	:	
Priority Date: 17 June 1998	:	
Attorney Docket No.: 3113FBR	:	
For: SOFTWARE VERIFICATION AND	:	
AUTHENTICATION	:	

This is a decision on applicants' (Renewed) "Petition to Revive an Abandoned Application under CFR 1.137(b)" filed 31 July 2003 in the above-captioned application. The above-captioned national stage application became abandoned for failure to submit an acceptable oath or declaration within the time period set forth in the "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) mailed 25 January 2001.

BACKGROUND

On 17 June 1999, applicant filed international application no. PCT/AU99/00486 which claimed a priority date of 17 June 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 23 December 1999. A Demand for international preliminary examination was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States at midnight on 17 December 2000.

On 15 December 2000, applicant filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; and a preliminary amendment.

On 25 January 2001, the PTO mailed a "Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)" (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) was required. The notification set a one-month period to respond.

On 26 September 2001, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a response to the Notification of Missing Requirements mailed 25 January 2001 within the time period set therein.

On 23 July 2002, applicant filed the petitions under 37 CFR 1.137(b) and 37 CFR 1.183. In a decision dated 20 September 2002, applicants' petitions were dismissed without prejudice.

On 31 July 2003, applicant filed the present renewed petition under 37 CFR 1.137(b) and 37 CFR 1.47(b).

DISCUSSION

Petition under 37 CFR 1.137(b)

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional," and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c). Pursuant to 37 CFR 1.137(b)(3), additional information may be required where there is a question whether the delay was unintentional. Items (2) and (4) have been satisfied.

As to item(1) has not been satisfied. The proper response was the submission of the declaration of the inventor which complies with 37 CFR 1.497(a) and (b). Petitioner states in the previous petition, "it is not possible to have the original inventors execute a Declaration and Power of Attorney." Therefore, in order to comply with the proper reply requirement of item (1) above for revival under 37 CFR 1.137(b), applicant must submit a petition under 37 CFR 1.47(b). Under the present circumstances, in order for the response requirement, to be satisfied, the petition under 37 CFR 1.47(b) to accept the application without the signature of inventor Thomas Eugene Bond, must be grantable. It is addressed below.

Item (3) has not been satisfied. While the required statement has been provided, additional information explaining the delay is now required. Specifically, applicant must provide a more detailed explanation of the lengthy delay in filing second petition to revive, as the entire delay must be unintentional for the application to be revived. Applicants must explain the original delay in filing an appropriate response (namely an executed declaration or a 37 CFR 1.47 petition) that resulted in the abandonment of the application, the delay in filing the first petition to revive and the delay in filing the appropriate reply (a 37 CFR 1.47(b) petition) with that petition, and the delay in filing the second petition to revive. MPEP 711.03(c)(III)(D). In particular, the Office wants to know where these files were located throughout this time (were they located at the original firm, did they remain in the custody of the firm or were they in the custody of the applicant), when did the various attorneys become aware of the abandonment of the application, when did the applicant

become aware of the abandonment and what provisions did the various attorneys have in place to track applications and their due dates, to prevent abandonments. Copies of documentary evidence that support the contention that the entire delay was unintentional should be submitted.

Since applicants have not met the requirements for revival of an application under 37 CFR 1.137(b), revival at this time would not be proper.

Petition under 37 CFR 1.47(b)

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(i); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the nonsigning inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. Items (1) through (3) and (6) under 37 CFR 1.47(b) have been satisfied.

Regarding Item (4), an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor has not been provided.

Concerning Item (5), section 409.03(f) of the M.P.E.P., **Proof of Proprietary Interest**, states, in part:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that, as of the date the application is deposited in the Patent and Trademark Office, (1) the invention has been assigned to the applicant, or (2) the inventor has agreed in writing to assign the invention to the applicant, or (3) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

If the application assigned, a copy of the assignment (in the English Language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant prior to the date the application is deposited in the Patent and Trademark Office. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324) . . .

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by affidavit or declaration that those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made

during employment. When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.

A proprietary interest obtained otherwise than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

As to item 5, petitioner has not submitted sufficient evidence that the inventor assigned the instant application to NuGame Inc., Aristocrat Leisure Industries Pty, Ltd; or Aristocrat Technologies Australia Pty, Ltd. Specifically, the assignment submitted by petitioner is directed to the invention entitled "Software Verification and Authentication" which is identified by Friedman Siegelbaum Docket No. 2583/NU (U.S. Provisional Serial No. 60/089,654). As stated in MPEP section 306, "[i]n the cases of a substitute or continuation-in-part, a prior assignment of the original application is not applied to the substitute or continuation-in-part application because the assignment recorded against the original application gives the assignee rights to only the subject matter common to both applications. Substitute or continuation-in-part application require a new assignment if they are to be issued to an assignee." Additionally, petitioner has not stated that the priority document and the instant application are identical. As stated above, when an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that, as of the date the application is deposited in the Patent and Trademark Office, (1) the invention has been assigned to the applicant, or (2) the inventor has agreed in writing to assign the invention to the applicant, or (3) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application. Therefore, further evidence is required to establish that the assignment in fact constitutes an assignment of the instant application to NuGame Inc., Aristocrat Leisure Industries Pty, Ltd; or Aristocrat Technologies Australia Pty, Ltd.

For the reasons stated above, it would not be appropriate to accept the application without the signature of Mr. Bond under 37 CFR 1.47(b) at this time.

CONCLUSION

For the reasons above, applicant's petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

Applicant's petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

The application remains **ABANDONED**.

If reconsideration on the merits of this petition is desired, an appropriate response to this decision must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)."

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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